



EJFW 1733
PATENT
Customer No. 22,852
Attorney Docket No. 7040.0098.00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Renato CARETTA)
Application Serial No. 09/937,601) Group Art Unit: 1733
Filed: September 28, 2001) Examiner: Johnstone, A.
For: TYRE FOR A VEHICLE WHEEL)
COMPRISING A PARTICULAR)
CARCASS STRUCTURE (AS)
AMENDED))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

Applicant respectfully requests reconsideration of the Office Action dated April 1, 2004, the period for response to which extends through July 1, 2004.

In the Office Action, the Examiner maintained the restriction requirement initially set forth in an Office Action dated October 6, 2003, and continued to withdraw claims 21-25 from consideration; required various headings in the specification; rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,328,084 (the '084 patent) or European Patent Application No. 0,928,680 (EP '680); and rejected claims 19 and 20 under obviousness-type double patenting over claim 32 of U.S. Patent No. 6,457,504 (the '504 patent) in view of the '086 patent or EP '680.

Withdrawn Claims 21-25

At the outset, Applicant continues to traverse the Examiner's restriction requirement, but acknowledges the Examiner's willingness to consider rejoinder of withdrawn claims 21-25 which incorporate allowable subject matter. As discussed in greater detail below, claim 17, from which claims 21-25 either directly or indirectly depend, is deemed allowable. Accordingly, upon allowance of claim 17, Applicant respectfully requests that claims 21-25 be rejoined and allowed along with dependent claims 18-20.

Requirement for Section Headings in the Specification

With respect to the Examiner's requirement that section headings be included in the specification, Applicant respectfully directs the Examiner's attention to a Preliminary Amendment filed in the present application on September 28, 2001, whereby Applicant amended the specification to include headings identified at pages 3-5 of the present Office Action. Applicant respectfully requests entry of those changes, if not already entered, and submits that the specification, as amended, complies with 37 C.F.R. 1.77(b). Accordingly, since appropriate section headings have been incorporated into the specification, no further specification changes should be deemed necessary, and Applicant respectfully requests the Examiner to withdraw the requirement to add various section headings.

Rejection of Claims 17 and 18 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the Examiner's rejection of claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the '084 patent or EP '680. In addition to failing to teach or suggest each and every element of claim 17 or 18, Applicant respectfully submits that the '084 patent does not

qualify as prior art, and the rejection under Section 103 should be withdrawn with respect to this document.

In particular, pursuant to 35 U.S.C. § 103(c):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claim invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The ‘084 patent has a provisional filing date of August 28, 1998, and an issue date of December 11, 2001. Applicant filed the present application on September 28, 2001. Therefore, the ‘084 patent can qualify as prior art, if at all, only under one or more of 35 U.S.C. § 102(e), (f), or (g), as required under § 103(c). As stated above, § 103(c) states that prior art under § 102(e) shall not preclude patentability of an invention if the invention was (1) developed by another person and (2) commonly owned or subject to an obligation of assignment to the same person. The ‘084 patent meets both of these requirements of § 103(c), because Renato Caretta is the inventor of the present application, and is therefore a different inventive entity than that of the ‘084 patent, which names both Renato Caretta and Maurizio Marchini as inventors. The present application, therefore, is to “another”, as set forth in § 103(c).

Moreover, the present application is assigned to Pirelli Pneumatici S.p.A., which is the same entity named as the assignee listed on the face of the ‘084 patent, as further required by § 103(c). The undersigned attorney therefore states on behalf of Applicant that the present application and the ‘084 patent were, at the time the present invention was made, owned by, or subject to an obligation of assignment to, the same corporate entity, i.e., Pirelli Pneumatici S.p.A. Accordingly, 35 U.S.C. 103(c) operates to remove the ‘084 patent as prior art in the present application.

Turning to the Examiner’s application of EP ‘680, Applicant submits that claim 17, for example, is not obvious over EP ‘680 because the document fails to teach or suggest each and every element of the claim. In particular, EP ‘680 at least fails to teach or suggest the claimed combination, as recited in

claim 17, including a third annular insert, and a primary portion of an annular reinforcing member, wherein the primary portion comprises an axially-inner side oriented toward terminal edges of a first series of strip segments and an axially-outer side oriented toward terminal edges of the second series of strip segments. The first and second series of strip segments are consecutively arranged along a circumferential development of a carcass structure.

As recited in claim 17, an annular reinforcing structure is provided having at least one primary portion, which includes first, second, and third annular inserts. Each of the first, second, and third annular inserts is positioned coaxially to a carcass structure.

The Examiner asserts that EP '680 discloses a "first circumferentially inextensible annular insert 27" and a "second circumferentially inextensible annular insert 28" (Office Action at page 6), which, as shown in Fig. 10, is provided between first carcass ply 3 and second carcass ply 31. The Examiner concedes, however, that EP'680 fails to disclose the claimed combination including a third circumferentially extensible annular insert (see Office Action at page 6), but argues that the claimed third annular insert would have been obvious.

Specifically, the Examiner cites portions of EP'680 describing an "alternative solution" whereby the second annular insert 28 is provided "subsequently to formation of the second carcass ply 31" (EP '680 at paragraph 110). In which case, apparently according to the Examiner, second annular insert 28 would be provided outside second carcass ply 31, such that portions of second carcass ply 31 would be provided between second annular insert 28 and first annular insert 27. The Examiner then concludes that "it would have been obvious ...[to provide] a circumferentially inextensible annular insert in both of the alternative locations for the second insert 28" (Office Action at page 6). To the extent the Examiner's position is understood, the Examiner apparently maintains that one of ordinary skill would modify the teachings of EP '680 to provide annular inserts between first (3) and second (31) carcass

plies and in the alternative location outside carcass ply 31. Thus, apparently according to the Examiner, it would be obvious to provide first (corresponding to annular insert 27), second (second annular insert 28 provided between the first and second carcass plies), and third (second annular insert 28 located at the alternative location outside second carcass ply 31 as described in paragraph 110) annular inserts. The Examiner's motivation for modifying EP '680 to include a third annular insert stems from the unsupported assertion that inclusion of third annular support would "further inhibit bead rotation." Applicant respectfully disagrees.

EP '680 clearly indicates that bead rotation is reduced by the *location* of the annular inserts 27 and 28, not the *number* of annular inserts present in the tyre:

In more detail, it is to note that the presence of the circumferentially inextensible annular inserts 27, 28 located internally of, and directly in contact with the respective carcass plies 3, 31 and mutually spaced apart by interposition of the filling body 29, efficiently prevents the bead from bending and rotating...

Emphasis added. Paragraph 141 of EP'680.

Thus, EP '680 teaches that bead rotation is inhibited by providing annular inserts 27 and 28 *internal* to carcass plies 3 and 31. EP'680 does not suggest that an annular insert located external to plies 3 and 31 would limit bead rotation. Accordingly, providing an additional annular insert external to carcass ply 31, as proposed by the Examiner, would not yield a further reduction in bead rotation according to EP '680. Applicant respectfully submits, therefore, that in light of the Examiner's recognition that EP '680 does not teach the claimed combination including a third annular insert, and the failure of the Office Action to provide adequate motivation to modify EP '680 to include the third annual insert, Applicant respectfully submits that claim 17 would not have been obvious over EP '680.

In light of the above-described deficiencies of EP ‘680, Applicant submits that claim 17 is allowable over the applied document, and claim 18 is allowable at least due to its dependence from claim 17.

Double Patent Rejections of Claims 19 and 20

Applicant respectfully traverses the Examiner’s double patenting rejection of claims 19 and 20 in view of claim 32 of the ‘504 patent and the ‘084 patent or EP ‘680. At the outset, Applicant respectfully notes that the ‘084 patent does not qualify as prior art under 35 U.S.C. § 103(c), and thus will not be discussed further.

Claim 19 depends from claim 17 and further recites that “the first series and the second series of strip segments are arranged in mutually-alternated sequence along the circumferential development of the carcass structure.” Claim 19, therefore, is directed toward, among other things, an arrangement of the first and second series of strip segments. The Office Action, however, states that the “claim 19 basic tire structure including the belt structure, tread band, and sidewalls is conventional tire structure.” (Office Action at page 7). By referring only to a “basic tire structure,” the Office Action fails to adequately address the language of claim 19.

Moreover, in rejecting claim 20, the Office Action merely refers to paragraph 8 (the double patenting rejection of claim 19), and does not even address the limitations of claim 20 at all. Thus, Applicant respectfully submits that in light of the failure of the Office Action to accurately characterize or even address the language of claims 19 and 20, the double patenting rejection of these claims should be withdrawn.

Further, neither claim 32 of the ‘504 patent nor EP ‘680 teach or suggest the subject matter recited in claims 19 and 20. As noted above, claim 19 is directed toward, among other things, an arrangement of the first and second series of strip segments “wherein the first series and the second

series of strip segments are arranged in mutually-alternated sequence along the circumferential development of the carcass structure.” Claim 20, depends from claim 19, and further recites, among other things, that:

each strip segment comprises two lateral portions and a crown portion,

wherein the lateral portions extend substantially toward a geometric axis of the carcass structure in positions mutually-spaced apart in an axial direction,

wherein the crown portion extends in a radially-outer position between the lateral portions, and

wherein the crown portions of the first series and the second series of strip segments are set mutually side-by-side along the circumferential development of the carcass structure.

Claim 32 of the ‘504 patent recites:

The tire of claim 31, wherein the at least one second annular insert is part of an additional portion of each annular reinforcing structure disposed against the end flaps of the strip sections of the second series on an opposite side relative to the at least one primary portion of each annular reinforcing structure.

Thus, claim 32 of the ‘504 patent is apparently directed toward, among other things, a feature of the “at least one second annular insert” claimed in that patent, and therefore recites different limitations than either claims 19 and 20 of the present application.

The Examiner contends that alleged teachings in EP ‘680 of “inhibit[ed] bead rotation.” (Office Action at page 7) render claims 19 and 20 obvious. As noted above, such teachings fail to teach or suggest the limitations of claim 17, from which claims 19 and 20 depend. Accordingly, EP ‘680 fails to establish that claim 19 is patentably indistinct from claim 32 of the ‘504 patent. Claim 20 is also patentably distinct from claim 32 of the ‘504 patent taken with EP ‘680 at least due to its dependence from claim 19. For these reasons also, Applicant respectfully requests that the Examiner’s double patenting rejection be withdrawn.

Claim Scope

In discussing the specification, claims, abstract, and drawings in this Request for Reconsideration, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicant believes that Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Summary

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By:



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Dated: June 30, 2004